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March 3, 2005

TO : U.S. PATENT AND TRADEMARK OFFICE

**ATTN: Mr. Leo Boudreau, Acting Director
Technology Center 2600 Communications
Serial No. 09/760,883 – filed January 17, 2001
In re Application of: Hiroyuki Shibata, et al.**

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FROM: H. J. Staas

**RE: REQUEST FOR RECONSIDERATION OF DECISION ON PETITION
MAILED FEBRUARY 9, 2005**

NO. OF PAGES (Including this Cover Sheet) 6

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COMMENTS:

Docket No.: 23.1093

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hiroyuki SHIBATA et al.

Serial No. 09/760,883

Group Art Unit: 2673

Confirmation No. 4981

Filed: January 17, 2001

Examiner: Vincent E. Kovalick

For: DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD
FOR THE DISPLAY APPARATUS

**REQUEST FOR RECONSIDERATION OF DECISION ON PETITION MAILED
FEBRUARY 9, 2005**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION

This is in response to the Decision on Petition mailed February 9, 2005. It is respectfully submitted that the foresaid Decision errs in its statements of the facts, in numerous substantive respects, and reconsideration accordingly is respectfully requested.

A. THE EXAMINER WITHDREW THE FINAL OFFICE ACTION OF JULY 28, 2004, AS APPLICANTS HAD REQUESTED - - AND NOT MERELY THE "FINALITY" THEREOF, AS THE DECISION INCORRECTLY STATES.

1. Applicants expressly requested a complete withdrawal of the Final Office Action, as evidenced by the title of the paper filed for that purpose on November 12, 2004:

**COMMUNICATION TO THE EXAMINER REQUESTING
WITHDRAWAL OF THE FINAL OFFICE OF JULY 28, 2004, SINCE
PREMATURE UNDER MPEP 706.07(C)-(E) AND ISSUANCE OF A
NEW, NON-FINAL OFFICE ACTION SETTING A NEW RESPONSE
PERIOD**

(Emphasis added)

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P.O. Box 1450, Alexandria, VA 22313-1450

On 3-3-05, 2005

STAAS & HALSEY

By: Heather P. Adams

Date 3-3-05

Serial No. 09/760,883

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2. The Examiner expressly recognized the nature of Applicant's request and expressly granted the relief which Applicant sought.

Particularly, The Office Action mailed January 12, 2005 expressly states at page 2:

Request For Withdrawal of Final Rejection

This Office Action is in response to Applicant's Request, dated November 12, 2004, for withdrawal of USPTO Final Office Action dated July 28, 2004.

* * *

...[T]he said USPTO Final Office Action dated July 28, 2004 is hereby withdrawn and a new Action is set forth herein below.

(Emphasis added, throughout)

3. The Decision on Petition, in the "Review of the File Records" at pages 1-2, Acknowledges the above Facts.

The Decision, in the second paragraph on page 2, acknowledges that the Applicant's request was:

...[T]o have the July 28, 2004 finality of the Office Action withdrawn, withdrawal of the Office Action in its entirety and issuance of a new, non-final Office Action setting a new response period.

(Emphasis added)

The Decision, however, in the sixth paragraph on page 2, then contradicts the above "facts" and states, incorrectly that:

...[T]he Examiner, in accordance with MPEP §706.07(a) and (d), agreed with Petitioner and withdrew the finality of the July 28, 2004 Action as stated in the first section of the Office Action mailed January 12, 2005.

This statement of the Decision contradicts, as well, the Examiner's statement in the January 12, 2005 Office Action, quoted in Section A (2) hereinabove.

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B. THE DECISION INCORRECTLY STATES THE PURPOSE OF THE DECEMBER 28, 2004 COMMUNICATION SUBMITTED BY APPLICANTS.

The Communication filed December 28, 2004 merely provided a written record of a discussion with the Examiner.

In the telephone conference with the Examiner on that day, the Examiner claimed to have no knowledge of the "Communication..." filed November 12, 2004. Accordingly, the Communication of December 28, 2004 supplied a courtesy copy of the November 12, 2004 Communication, along with a copy of the USPTO Post Card receipt for same and the PAIR Report, both of which confirmed the filing of same.

Kawakami was also discussed with the Examiner and the December 28, 2004 Communication merely made that discussion with the Examiner of record. Applicant's counsel in no way intended that brief discussion of Kawakami to constitute a response to the Office Action

C. THE OFFICE ACTION MAILED JANUARY 12, 2005 MAKES CLEAR THAT THE EXAMINER DID NOT CONSIDER THE DISTINCTIONS OVER KAWAKAMI PRESENTED IN THE COMMUNICATION OF DECEMBER 28, 2004

The Office Action mailed January 12, 2005, at page 1 of the Summary, expressly states that it is "Responsive to Communication(s) filed 12 November 2004." That is repeated at page 2, the first paragraph. No reference is made therein to the December 28, 2004 paper.

Indeed, the Examiner made it indisputably clear, in the January 12, 2005 Office Action, that he had given no consideration to Applicant's contentions as to Kawakami, as were presented in the December 28, 2004 paper, by stating:

In that new prior art has been introduced in the rejection of claims 1, 10, 14, 19, 23, 27, 34, 35, 36, 38, and 39, Applicant's remarks relative to said claims are rendered moot.

(Action of January 12, 2005 at page 2)

This is the identical statement which appears in the Office Action mailed July 28, 2004 and which was considered to have been prematurely made Final by the Examiner - - and, as well, was so declared in the Decision. The "Applicant's remarks..." which were rendered "moot" ... necessarily were those urged in earlier stages of prosecution, as to references now withdrawn from consideration.

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D. THE DECISION ON PETITION ERRS IN ADDRESSING THE REQUEST OF DECEMBER 28, 2004 AS A RESPONSE TO THE FINAL OFFICE ACTION OF JULY 28, 2004 AND FURTHER ERRS IN CHARGING APPLICANT'S DEPOSIT ACCOUNT FOR A TWO-MONTH EXTENSION OF TIME

The Examiner acted properly in withdrawing the July 28, 2004 Office Action and issuing the new Office Action of January 12, 2005 in its place. By that Action, the July 28, 2004 Final Rejection was rendered a nullity.

Accordingly, there was no need for Applicants to have filed a Response to the July 28, 2004 Office Action -- and, it follows, no Extension of Time was required.

E. IF THE DECEMBER 28, 2004 COMMUNICATION IS PROPERLY VIEWED AS A RESPONSE TO THE JULY 28, 2004 OFFICE ACTION, THEN THE JANUARY 12, 2005 OFFICE ACTION IS PREMATURELY MADE FINAL, SINCE FAILING TO ADDRESS APPLICANT'S ARGUMENTS TRAVERSING THE REJECTIONS BASED ON KAWAKAMI

The Final Action mailed January 12, 2005 simply does not address the contentions set forth in the December 28, 2004 request as to the irrelevancy of Kawakami. As demonstrated above, the Examiner merely repeated, verbatim, the content of the July 28, 2004 rejection -- which, inherently, could not have been responding to the Remarks of the December 28, 2004 request.

If the January 12, 2005 Office Action is to be viewed as responding to the December 28, 2004 Communication, it is prematurely made Final since not addressing Applicant's arguments -- and thus the Action and finality of same should be withdrawn, as premature.

F. APPLICANTS HAVE BEEN DENIED THE OPPORTUNITY TO RESPOND TO A NON-FINAL OFFICE ACTION REJECTING CLAIMS ON THE BASIS OF THE KAWAKAMI REFERENCE

Applicants have never had an opportunity to respond to claim rejections based on the Kawakami reference, newly cited in the July 28, 2004 Office Action, as a non-final Office Action.

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G. RELIEF SOUGHT HEREIN

It is submitted that the only Action of record against the present application, since the Final Rejection of July 28, 2004, is the Action mailed January 12, 2005 -- which is improperly made Final since constituting a first Office Action applying the Kawakami reference in the rejection of claims. It should be withdrawn and a new non-final Office Action issued, to which Applicants for the first time will have the opportunity to make a full Response. Such action is earnestly solicited.

If any Petition or other fees are due for this Request, Commissioner is authorized to charge fees to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: March 3, 2005By: 

H. J. Staas

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